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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,370	09/11/2006	Adrian Francis Backes	KPT 1102 (GHS/P501842US)	2831
321 7590 10/12/2007 SENNIGER POWERS ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			EXAMINER CHANDRAKUMAR, NIZAL S	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 10/12/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

Office Action Summary	Application No.	Applicant(s)	
	10/582,370	BACKES ET AL.	
	Examiner	Art Unit	
	Nizal S. Chandrakumar	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

This application filed 09/11/2006 is a 371 of PCT/GB04/05054 12/01/2004.

Claims 1-23 are before the Examiner.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 and dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim contains the phrase 'operating under reaction conditions'. The purpose of this language is unclear and confusing because all reactions have some 'reaction conditions'. The claim also contains the term 'depleted' without clearly stating what the stream is depleted off.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18, 20-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the process of production of one cyclic ether does not reasonably provide enablement for the formation of generically claimed cyclic and non-cyclic ethers. The specification is enabling for the formation of THF using methyl maleate. The specification is not enabling for the production all possible ethers such as ethers corresponding to traumatic acid. In addition, it is not seen where the specification teaches a process which includes an esterification step (pertaining to claims 20-22). The specification

Art Unit: 1625

does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Enablement is considered in view of the Wands factors (MPEP 2164.01 (a)). These include: (1) breadth of the claims; (2) nature of the invention; (3) state of the prior art; (4) amount of direction provided by the inventor; (5) the level of predictability in the art; (6) the existence of working examples; (7) quantity of experimentation needed to make or use the invention based on the content of the disclosure; and (8) relative skill in the art.

All of the factors have been considered with regard to the claim, with the most relevant factors discussed below:

Nature of the invention: The present invention relates to a process for the production of ethers optionally with the co-production of diols and/or lactones which includes hydrogenation of an organic feed material comprising one or more compounds having a carbon carbon double bond.

Breadth of the claims: The claims are drawn to processes using a variety of undefined starting materials selected from unsaturated dicarboxylic acids and/or anhydrides, mono-esters of unsaturated dicarboxylic acids and/or anhydrides, diesters of unsaturated dicarboxylic acids and/or anhydrides, unsaturated lactones, and mixtures of. Thus the breadth of the claims is large, one that is not supported by the specification.

The level of the skill in the art: The level of skill in the art is high. However, due to the unpredictability in organic chemical processes each embodiment of the invention is required to be individually assessed for viability.

State of the prior art, the amount of direction provided by the inventor and the existence of working

examples: While the catalytic hydrogenation of double bonds as well as the reduction of carbonyl compounds to alcohols are well-known and established in the art of organic chemistry, the cyclization of diols to form cyclic ethers is unpredictable. Further more, the actual mechanism of formation of cyclic ethers from cyclic substrates such as anhydrides and lactones is not well understood. Factors governing cyclization such as size of the ring that is formed as well as dehydration in the case of aliphatic alcohols, concentration of the substrates, in the case of bimolecular kinetics, are art recognized to be of relevant in such processes. Furthermore the cyclization also depends on the catalyst which is susceptible to poisoning depending on the substrate. The need for vaporization limits what substrates could be gainfully used in the disclosed process. The existence of such unpredictabilities and limitations would prevent one of ordinary skill in the art from accepting the two disclosed working examples for the formation of a C4-cyclic ether, on its face as universally applicable to formation of all permutations and combination of non-cyclic ethers and cyclic ethers encompassed by the claims. The specification also does not teach the use of catalyst other than Pd.

It is not seen where the specification teaches a process that includes an esterification step.

Quantity of experimentation needed to make or use the invention based on the content of the disclosure: In the instant case, there is a substantial gap between the process described and what is being claimed. Given the undefined nature of the starting materials and the limited number of working examples, in order to utilize the invention as claimed, the skilled artisan would be presented with an unpredictable amount of experimentation. Consequently, a burdensome amount of research would be required by one of ordinary skill in the art to bridge this gap. The instant disclosure is broad and generic.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states, "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

Art Unit: 1625

What is enabled in the specification is a vapor phase process for the production of tetrahydrofuran starting either from dimethyl maleate and or dimethyl succinate in the presence of hydrogen and palladium catalyst.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-23 are rejected under 35 U.S.C. 102(a, e) as being anticipated by Sutton et al. (US 6936727 B2).

The process described in the prior art is the same as the process claimed in the instant application based on the publishing date of the US patent 08/30/2005. Further, the 102(e) rejections is based on the effective filing date of 07/10/2002.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1625

6. Claims 1-23 are rejected on the ground of nonstatutory double patenting over claims 1-15 of U. S. Patent No. 6936727 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims of the prior art and the instant application are drawn to the production of tetrahydrofuran from dimethyl maleate. The difference is that in the instant case the claims are generic as well as specific to the formation of tetrahydrofuran.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nizal S. Chandrakumar whose telephone number is 571-272-6202. The examiner can normally be reached on 8.30 am – 5 pm Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached at 571-272-0867 or Primary Examiner D. Margaret Seaman can be reached at 571-272-0694. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative

Application/Control Number: 10/582,370

Page 7

Art Unit: 1625

or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nizal S. Chandrakumar



D. MARGARET SEAMAN
PRIMARY EXAMINER